

Application No. 10/787,188
Amendment dated March 20, 2006
Reply to Office Action of October 18, 2005

Docket No.: 4699-0103P

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings includes changes to Figure 11 to indicate that it is (Conventional Art)..

Attachment: Replacement sheet

REMARKS

Claims 1-22 are pending in the above application. By the above amendment, claims 20-22 have been added and claims 15 and 19 have been cancelled.

The Office Action dated October 18, 2005, has been received and carefully reviewed. In that Office Action, claims 1-14 were rejected under 35 U.S.C. 102(b) as being anticipated by Onishi, U.S. 2001/0053074 (hereinafter, "Onishi"). Claims 15-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi. Claims 1 and 8 were also objected to for formal reasons. Reconsideration and allowance of claims 1-14, 16-18 and 20-22 is respectfully requested in view of the above amendments and following remarks.

DRAWINGS

The Office Action is requiring that Figure 11 be labeled with a legend such as "Prior Art." The legend "Conventional Art" has been added to Figure 11 of the enclosed drawings. It is submitted that this amendment complies with the requirement for an amended drawing figure.

CLAIM OBJECTIONS

Claims 1 and 8 are objected to for using the word "outside." It is believed that the meaning of the term "outside" is clear from the specification. For example, page 11, lines 6-8 provide that "Light-guiding plate body 101 (element body) has a generally plate shape constituted with a material having a larger refractive index (electric permittivity) than the outside air layer." It is therefore not believed that any amendment to claims 1 and 8 is necessary. However, in order to improve the readability of these claims, claims 1 and 8 have been amended to refer to "air outside said element body." It is respectfully submitted that this amendment is not being made for reasons related to patentability because it is being made in response to an objection rather than a rejection.

In addition, it is respectfully submitted that claims 1 and 8 are being amended in a manner that was to be expected in view of the objection raised in the Office Action. As provided in the MPEP, "A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on

prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element (emphasis added).” MPEP 706.07(a). Therefore, if a new rejection is made in connection with claims 1 and/or 8, it is respectfully submitted that such a rejection should be made in a non-final Office Action.

REJECTIONS UNDER 35 U.S.C. 102(b)

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Onishi. Claim 1 requires a surface radiation conversion element that includes, *inter alia*, an element body having a general plate shape having a plurality of closed spaces inside the element body which have an electrical permittivity smaller than that of the material constituting the element body. The Office Action refers to element 3 of Onishi as an element body. However, it is respectfully submitted that there are no closed spaces inside element 3 of Onishi. The Office Action refers to “air holes,” but neither Figure 10, referred to in the Office Action, or any other portion of Onishi shows or describes air holes. Onishi’s body 3 appears to be solid and does not include closed spaces as required by claim 1.

There appear to be open channels between elements 3 and 4 of Onishi. However, these channels are open at both ends and do not satisfy the limitation of “closed spaces.” No element in Onishi corresponds to an element body having a plurality of closed spaces inside the element body as required by claim 1. Claim 1 is submitted to be allowable for at least this reason.

If this rejection is maintained, it is respectfully requested that the examiner identify the “air holes” referred to in the Office Action or show or describe in greater detail where such closed spaces are believed to be shown in Onishi.

Claims 2-7 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 8 is also rejected under 35 U.S.C. 102(b) as being anticipated by Onishi. Claim 8 also requires, *inter alia*, an element body having a generally plate shape having a plurality of

closed spaces inside the element body. Claim 8 is submitted to be allowable over the art of record for at least the same reasons as Onishi.

Claims 9-14 depend from claim 8 and are submitted to be allowable for the same reasons as claim 8.

Applicant acknowledges that an examiner must give claims their broadest reasonable meaning. However, each element of the claim must still be present in the reference in order to support a rejection under 35 U.S.C. 102. Each element required by claims 1-14 is not present in Onishi, and claims 1-14 are therefore submitted to be allowable over the art of record.

In addition, the examiner seems to object to functional language in the claims. Claims 1 and 8 do not appear to include any objectionable functional language, and no specific language has been identified by the Office Action. Even if the examiner is objecting to certain functional language, it is respectfully submitted that such language must be considered in examining the claims. As provided in the MPEP, "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 169 U.S.P.Q. 226 (CCPA 1971); MPEP 2173.05(g). That section goes on to provide that "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." Therefore, even if certain language in the claims is believed to be functional, it still must be considered. If the examiner has other objections to any functional language in the claims, it is respectfully requested that the specific language that the examiner finds objectionable be identified along with a basis for objecting to the language. Applicant will attempt to address any such objections in a future response.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi. By the above amendment, claim 15 has been cancelled and rewritten as claim 20 which claim more clearly recites a series of process steps. Onishi does not show or suggest forming a plurality of recesses in a first member as claimed. Onishi does not show recesses having a smaller electric

permissivity that the permissivities of the first and second members. Claim 20 and its dependent claims 16-18, 21 and 22 are therefore submitted to be allowable over Onishi.

CONCLUSION


Each issue raised in the Office Action dated October 18, 2005, has been addressed, and it is believed that claims 1-14, 16-18 and 20-22 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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